

STATUS OF THE CLAIMS

Claims 1-40 are pending in the Application

Claims 1-40 are finally rejected by the Examiner.

Applicant has herein amended independent Claims 1, 13, 14, 23 and 32, without prejudice or disclaimer.

Accordingly, reconsideration of the present Application is respectfully requested.

REMARKS

Amendment After Final

Entry of this Amendment is respectfully requested on the ground that this Amendment places the application in condition for allowance. Alternatively, entry of this Amendment is respectfully requested on the ground that this amendment places the claims in better form and condition for appeal. Furthermore, Applicant submits that any changes made to the claims herein do not require an additional search on the part of the Office, nor do any amendments made herein raise new issues with regard to the patentability of the claims now pending.

Claim Rejections Pursuant to 35 U.S.C. §102(b)

Claims 1-4, 6-15, 17-24, 26-32 and 35-40 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,831,526 to Luchs et al., in view of "Instant Auto Insurance quotes Now Available at Quotesmith.com" to Bland, for the same reasons given in the previous Office Action (paper number 10; Office Action Dated 9/6/01).

Applicant notes that the above rejections based upon Luchs and Bland were presented in the Office Action dated 9/06/01 as 35 U.S.C. 103(a) rejections, and are now presented as 35 U.S.C. 102(b) rejection references. Notwithstanding this change, Applicant traverses these rejections, and deems them overcome, for at least the following reasons:

All claim limitations expressed in amended Claims 1, 13, 14, 23 and 32 of the present invention are not found, either expressly or inherently, in a single prior art reference.

35 U.S.C. 102(b) recites:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Accordingly, MPEP 2131 states:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Amended Independent Claim 1 is typical of the amendments of the amendments of Claims 1, 13, 14, 23 and 32 and recites:

1. (Amended) A method of processing an insurance application, comprising the steps of:

receiving an application for a policy of insurance from a user over a computer network;

automatically approving or denying the application based on a comparison of data contained in the application with stored underwriting criteria;

automatically offering a policy of insurance to the user in response to the application over the computer network if the application is approved and presenting the policy to the user for electronic acceptance; and

issuing and activating the policy upon electronic acceptance thereof by the user and payment via an electronic payment, wherein all of the steps of said method occur during a single user session on the computer network and the policy of insurance provides insurance coverage for the user without a post user-session delay period.

Amended Claims 1, 13, 14 , 23 and 32 comport with the specification of the subject Application, such as on page 21, middle and last paragraph wherein it is stated:

The user is given an opportunity to accept the policy electronically in step 214 by clicking on region 664, which is labeled "I accept". Doing so results in the issuance of the policy to the user (step 216). The user may print or save the policy from his Web browser. In addition, the user may return to the Web site to view the policy at any time.

Additionally, on specification page 22, first paragraph, it is stated:

If payment is made, the insurance is automatically activated during the user session.

Examiner states that the Applicants' remarks filed 1/07/02 are not persuasive. Yet, in the Office Action dated 9/6/01, Examiner asserted:

Luchs et al fails to teach the claimed issuing the policy upon electronic acceptance of the user when all steps are completed during a single user session.

The Applicant agrees with the above statement concerning the Luchs et al statement. Additionally, Examiner asserts:

Bland teaches a system of receiving instant automobile insurance quotes from over 300 insurance companies on the Internet and if the customer is satisfied with the quote the policy could be purchased immediately on-line (see: paragraph 1 and 3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the insurance application system as taught by Luchs et al. with the insurance quotes system as taught by Bland in order to facilitate the process of getting insurance quotes because this would allow the user to receive the most accurate, thorough and lowest automobile insurance coverage available.

Applicant asserts that Luchs does not teach all of the claim elements of amended Claims 1, 13, 14, 23 and 32. Luchs does not teach, explicitly or inherently, the element of issuing and immediately activating the policy upon electronic acceptance thereof by the user and payment via an electronic payment scheme, wherein all of the steps occur during a single user session on the computer network and the policy of insurance provides immediate insurance coverage for the user without a post user-session delay period.

Applicant asserts that the Bland reference does not teach the elements of amended Claims 1, 13, 14, 23 and 32 that are lacking in Luchs. Applicant asserts that Bland explicitly teaches away from issuing and immediately activating the policy upon electronic

acceptance thereof by the user and payment via an electronic payment scheme, wherein all of the steps occur during a single user session on the computer network and the policy of insurance provides immediate insurance coverage for the user without a post user-session delay period. This explicit teaching-away from the present invention is evident in the Bland-referenced website, Quotesmith.com. Applicant has previously provided Examiner a hardcopy print of the website, including Frequently Asked Questions. Specifically, the Bland reference includes the following relevant FAQ:

"When can my policy start?"

This will vary by company. In many cases, this can start as early as tomorrow. In some other cases, companies offering preferred rates (the lowest possible rates) may require that the policy begin as much as five days from your application date.

Explicitly, the Bland reference states that a policy can start "as early as tomorrow." Within any possible rational lexicon, the above statement explicitly eliminates the possibility of a policy starting any earlier than tomorrow. Therefore, a policy starting insurance coverage immediately, as in amended Claims 1, 13, 14, 23 and 32, is clearly taught against by the Bland reference. Applicant notes that allowing for an immediate purchase of a policy does not provide an immediate confirmation of the activation of the policy, i.e. an immediate purchase does not provide immediate insurance coverage, in Luchs or Bland.

Since the Examiner has stated that Luchs fails to teach the claimed issuing the policy upon electronic acceptance of the user when all steps are completed during a single user session, Luchs alone cannot anticipate amended Claims 1, 13, 14, 23 and 32. Further, since Bland explicitly teaches away from the immediate start, issuance, and activation for immediate coverage of a policy, Bland cannot anticipate amended Claims 1, 13, 14, 23 and 32. Additionally, Bland teaches away from the combination asserted by the Examiner, and even if Luchs and Bland were combined, the combination does not anticipate amended Claims 1, 13, 14, 23 and 32.

Therefore, the 35 U.S.C 102(b) rejection is traversed and deemed overcome.

If it was intended that Luchs and Bland were the basis of a continued 35 U.S. C 103(a) rejection from the Office Action dated 9/6/01, Applicant submits that the combination of Luchs and Bland, taken together, would not render obvious amended

Claims 1, 13, 14, 23 and 32 of the present invention, because obviousness requires that the prior art references, individually or when combined, must teach or suggest all claim limitations. As discussed above, the issuing and immediately activating of the policy upon electronic acceptance thereof by the user and payment via an electronic payment scheme, wherein all of the steps occur during a single user session on the computer network and the policy of insurance provides immediate insurance coverage for the user without a post user-session delay period, is not taught in Luchs and/or Bland, when considered individually or in the aggregate. Indeed, Bland specifically teaches away from amended Claims 1, 13, 14, 23 and 32.

Examiner expresses that Applicant did not address Luchs and Bland in combination. Applicant notes that Applicant specifically addressed this combination in that a combination cannot teach what the references do not teach. Nonetheless, Applicant has herein considered the references both together and separately, for purposes of both 35 U.S.C. 102(b) and 35 U.S.C. 103(a).

Applicant respectfully submits that independent Claims 1, 13, 14, 23 and 32 are now in a condition for allowance. Similarly, dependent Claims 2-4, 6-13, 15, 17-22, 24, 26-31, 33 and 35-40 are also in a condition for allowance, based at least upon an ultimate dependence on an allowable independent claim.

Claim Rejections Pursuant to 35 U.S.C. 103

Claims 5, 16, 25 and 34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent No. 4,831,526 to Luchs et al., in view of U.S. Patent No. 6, 064,987 to Walker et al., for substantially the same reasons given in the previous Office Action (paper number 10; Office Action Dated 9/6/01).

35 U.S.C. 103(a) recites:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

MPEP 706.02(j) recites:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The Examiner states in the Office Action dated 9/6/01 that Luchs combined with Bland fails to explicitly teach a method for receiving a credit card number from the applicant prior to issuance of the policy for use in payment of premiums. The Examiner also states that Walker discloses the use of credit cards to pay for any desired purchase. The Examiner concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to use credit cards, as shown by Walker, in an insurance application system, as taught by Luchs and Bland, in order to create a more efficient and effective method of payment for the insurance policy.

The Applicant respectfully disagrees with the Examiner's conclusions.

MPEP 706.02(j) recites, in part:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references (or references when combined) must teach or suggest all claim limitations.

The cited references fail to teach or suggest all of the claim limitations of claims 5, 16, 25, and 34. Walker fails to teach or suggest issuing and immediately activating of the policy upon electronic acceptance thereof by the user and payment via an electronic payment scheme, wherein all of the steps occur during a single user session on the computer network and the policy of insurance provides immediate insurance coverage for the user without a

post user-session delay period. Applicant submits that the mere use of a credit card does not result in the immediate issuing and activation, i.e. start of insurance coverage, of a policy of insurance in combination with any of the above cited references.

Neither Luchs nor Bland, individually or in combination, anticipates amended Claims 1, 13, 14, 23 and 32, and the combination of Luchs and Bland does not render obvious amended Claims 1, 13, 14, 23 and 32, at least because of the failure of the combination to teach the issuing and immediate activating of the policy upon electronic acceptance thereof by the user and payment via an electronic payment scheme, wherein all of the steps occur during a single user session on the computer network and the policy of insurance provides immediate insurance coverage for the user without a post user-session delay period. Further, Walker, which discloses the use of a credit card for a purchase, does not teach issuing and immediately activating a policy of insurance such that the immediate insurance coverage is provided to the user without a post user-session delay.

Further, Claims 5, 16, 25, and 34 are dependent on Claims 1, 14, 23 and 32, respectively. Since defendant claims serve to further narrow the respective independent claims, and the respective independent claims are allowable as stated hereinabove, Claims 5, 16, 25, and 34 are allowable.

Conclusion

Applicants respectfully request reconsideration of the subject application in light of the reasons set forth herein. Applicants assert that the amendments place the claims in a condition for allowance, and thus Applicant respectfully requests early and favorable action on Claims 1-40.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Amended Claims

Please amend, without prejudice or disclaimer, Claims 1, 13, 14, 23 and 32 as follows:

1. (Amended) A method of processing an insurance application, comprising the steps of:
receiving an application for a policy of insurance from a user over a computer network;
automatically approving or denying the application based on a comparison of data contained in the application with stored underwriting criteria;
automatically offering a policy of insurance to the user in response to the application over the computer network if the application is approved and presenting the policy to the user for electronic acceptance; and
issuing and activating the policy upon electronic acceptance thereof by the user and payment via an electronic payment,
wherein all of the steps of said method occur during a single user session on the computer network, and wherein the policy of insurance provides insurance coverage for the user without a post user-session delay period.

13. (Amended) A method of processing an application for an amendment to an existing policy of insurance, comprising the steps of:
receiving an application for an amendment to a policy of insurance from a user over a computer network;
automatically approving or denying the application based on a comparison of data contained in the application with stored underwriting criteria;
automatically offering an amended policy of insurance to the user in response to the application over the computer network if the application is approved and presenting the policy to the user for electronic acceptance; and

issuing and activating the policy upon electronic acceptance thereof by the user and payment via an electronic payment,

wherein all of the steps of said method occur during a single user session on the computer network, and wherein the policy of insurance provides insurance coverage for the user without a post user-session delay period.

14. (Amended) A computerized system for processing an insurance application during a single user session, comprising:

means for receiving an application for a policy of insurance from a user over a computer network during a user session;

means for automatically approving or denying the application during the user session based on a comparison of data contained in the application with stored underwriting criteria;

means for automatically offering a policy of insurance during the user session in response to the application over the computer network if the application is approved and presenting the policy during the user session to the user for electronic acceptance; and

means for issuing and immediately activating the policy during the user session upon electronic acceptance thereof by the user and payment via an electronic payment,

wherein the issued and activated policy of insurance provides insurance coverage for the user without a post user-session delay period.

23. (Amended) A computerized system for processing an insurance application during a single user session, comprising:

a server; and

a database;

wherein said server transmits an application for a policy of insurance to a user over a computer network during a user session in response to a request therefore from the user;

wherein the server automatically approves or denies the application during the user session based on a comparison of data contained in the application with stored underwriting criteria;

wherein said server automatically offers a policy of insurance to the user over a computer network during a user session in response to the application over the computer network if the application is approved and presents the policy during the user session to the user for electronic acceptance; and

wherein said server issues and activates the policy during the user session upon electronic acceptance thereof by the user and payment via an electronic payment,

wherein the issued and activated policy of insurance provides insurance coverage for the user without a post user-session delay period.

32. (Amended) A computer-readable medium tangibly embodying instructions which, when executed by a computer, implement the process of :

receiving an application for a policy of insurance from a user over a computer network; automatically approving or denying the application based on a comparison of data contained in the application with stored underwriting criteria;

automatically offering a policy of insurance to the user in response to the application over the computer network if the application is approved and presenting the policy to the user for electronic acceptance; and

issuing and activating the policy upon electronic acceptance thereof by the user and payment via an electronic payment,

wherein all of the steps of said method occur during a single user session on the computer network, and wherein the policy of insurance provides insurance coverage for the user without a post user-session delay period.